

Application No.: 10/521,925
Filing Date: August 16, 2005

REMARKS

Claims 1-5 and 7-15 are pending in the present application. Claims 3, 4, 11 and 12 have been amended. Claim 6 has been previously canceled without prejudice or disclaimer. Support for the amendments can be found throughout the specification and claims as originally filed. More particularly, support for the amendment to Claims 4 and 12 can be found in, for example, Paragraph [0012] of the specification as published. Support for the amendment to Claim 3 can be found in, for example, Paragraph [0011] of the specification as published. Claim 11 has been amended to correct dependency. No new matter is added by the present amendments. Entry of the amendments to the claims and reconsideration is respectfully requested.

The Applicant acknowledges that Claims 5 and 13 are allowed subject matter that is objected to as being dependant upon a rejected base claim. For the reasons stated below, the Applicant asserts the remaining pending claims should be allowed, and therefore amendment of Claims 5 and 13 to independent form is unnecessary.

Objection to Claim 3 under 37 C.F.R. 1.75(c)

Claim 3 was objected to as an improper dependant claim. Claim 3 has now been amended as suggested in the Office Action. Withdrawal of the objection under 37 C.F.R. 1.75(c) is respectfully requested.

Rejection of Claims 4 and 12 under 35 U.S.C. §112

Claims 4 and 12 were rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the term "virtually" a poly-L-Lactic acid polymer has been rejected as indefinite. Claims 4 and 12 have been amended to recite that "substantially all" of the lactic acid polymer is poly-L-Lactic acid. A standard dictionary definition of "virtually" is "almost or nearly." The amended claim incorporates standard claim language for expressing this type of concept in place of "virtually." Withdrawal of the rejection under 35 U.S.C. §112 is respectfully requested.

Rejection of Claims 3 under 35 U.S.C. §103(a)

Claims 1-4, 7-12 and 14-15 were rejected under 35 U.S.C. §103(a) for alleged obviousness over Li (WO 00/19837). The Office Action states that Li fails to disclose a gum composition that contains lactic acid polymers having a glass transition temperature of 55 to 80°C. The Office Action states that it would nevertheless be obvious to modify the teachings of Li to include a more crystalline lactic acid polymer (*i.e.*, a polymer having a higher glass transition temperature) for the purposes of making a chewing gum that degrades slower and lasts longer while chewing.

Applicant submits that the claims as presently pending are non-obvious over the cited references. In particular, the claims are non-obvious because the asserted reasons for modifying the teachings of Li would be contrary to the stated purposes of Li.

As set forth in MPEP § 2143, in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 127 S. Ct. 1727, 82 USPQ2d 1385, 1395-97 (2007) the Supreme Court identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The KSR Court noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.

In order to meet this burden, the Examiner relies upon Li's teaching that "[i]t has also been found that poly(D,L-lactic acid) degrades much faster than crystalline PLLA," as a basis for modifying Li to obtain a slower degrading polymer. However, no citation from Li is provided why slower degradation would be desirable, and the Applicant asserts that none is present. In fact, Li teaches the desirability of "rapidly degradable" chewing gum to alleviate the nuisance of improperly disposed gum cuds that adhere to unwanted surfaces (*See Li* at page 1, lines 16-30). From the passage in Li, it is clear that Li prefers a rapidly degrading gum. This is in stark contrast to Claims 1 or 10, which have polymers with higher glass transition temperatures that, according to Li, would provide undesirable gum cuds. Only with impermissible hindsight can this clear teaching away be construed as a suggestion to do the opposite of what the reference teaches.

Moreover, Li teaches poly(D,L-lactic acid) and poly(D,L-lactide acid-co-glycolic acid) as equivalents for use in chewing gums (*See e.g., Li* at page 7, line 8-9). Because poly(D,L-lactide-co-glycolic acid) degrades more rapidly than lactic acid polymers, a person of ordinary skill would recognize that faster degradation is not detrimental. In contrast, Li teaches that poly(L-lactic acid) has slower degradation and is unsuitable for use in chewing gums. Thus, when these teachings are combined with the stated purpose of obtaining "rapidly degradable" chewing gum, Li unambiguously discourages using polymers having slower degradation.

No reason for using slower degrading polymers is found in Li because this is clearly contrary to Li's teachings. Nevertheless, the PTO posits that slower degrading polymers would be desirable because the gum will last longer while chewing. Even if Li's teaching away from slower degrading polymers is ignored, this rationale would still be improper due to the inherent degradation properties of lactic acid polymers. Poly(D,L-lactic acid) degrades over a period of about several months or more, and as such, does not substantially degrade during typical use (*e.g.,* about 1 hour). Because the degradation of Poly(D,L-lactic acid) would not occur during normal use, there is no advantage to including slower degrading polymers. A person of ordinary skill would have no reason to extend the chewing lifetime of the gum disclosed in Li.

As such, the Examiner has not established a prima facie case of obviousness because the asserted rationale for rejecting Claims 1-4, 7-12 and 14-15 is improper. Li clearly teaches the desirability of rapidly degrading gums, and therefore obtaining a slower degrading gum is not a proper basis for obviousness.

For at least the reasons presented above, the Claims 1-4, 7-12 and 14-15 are nonobvious over the prior art. Withdrawal of the § 103(a) rejection is respectfully requested

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure,

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including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Respectfully submitted,

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Dated: March 19, 2009

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